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09/781,253	02/13/2001	Takumi Hasegawa	Q63086	8082
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EXAMINER DAY, HERNG DER				
ART UNIT 2128		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/781,253		HASEGAWA, TAKUMI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Herng-der Day		2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,9-11,17,23 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,9-11,17,23 and 27-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This communication is in response to Applicant's Amendment ("Amendment") to Office Action dated January 12, 2007, mailed April 12, 2007.

1-1. Claims 1, 9-11, 17, 23, and 27-29 have been amended. Claims 24-26 have been canceled. Claims 30-37 have been added. Claims 1, 2, 4, 9-11, 17, 23, and 27-37 are pending.

1-2. Claims 1, 2, 4, 9-11, 17, 23, and 27-37 have been examined and rejected.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 27-29 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3-1. Claims 27, 29, and 31 respectively recite the amended limitation, "wherein said additional personal information of the specific user matches categories, wherein said categories are common to a group of users", which does not appear to have support in the original disclosure. Applicant should explicitly provide the support for this amended limitation. Claim 28 is rejected as being dependent on a rejected claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2128

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5-1. Claim 17 recites the limitation “said additional personal information of the specific user” in line 20 of the claim. There is insufficient antecedent basis for this limitation in the claim.

5-2. Claim 23 claims a server. However, claim 23 also recites the limitation “wherein the terminal includes an information entry selecting means allowing a user to either, enter design information without downloading public design data, or request transfer of said public design data from the design data publicizing processing unit to the user together with an editing program file” at the end of the claim. It is unclear whether the claimed server comprises the recited “terminal”.

### ***Recommendations***

6. Claims 36 and 37 recite the limitation “the personal information” in lines 1-2 of each claim. For clarification purposes, the Examiner suggests that “the personal information” be replaced with “the additional personal information”.

7. Claim 32 recite the limitation “The user’s request reflecting system” in line 1 of the claim. For clarification purposes, the Examiner suggests that “The user’s request reflecting system” be replaced with “The user’s request reflecting design system”.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 9 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Berger et al., U.S. Patent 6,414,693 B1 issued July 2, 2002, and filed October 12, 1999.

9-1. Regarding claim 9, Berger et al. disclose a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

correction data receiving means for receiving and storing correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

design assisting means for reflecting said correction data (coordinate location, column 8, lines 6-9) received by said correction data receiving means on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

Wherein said design data publicizing means includes

Art Unit: 2128

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein the terminal includes

an information entry selecting means allowing a user to either, enter design information without downloading public design data (Additional instruction dialog boxes ... provide more-specific instructions for producing an actual, physical version of the article, column 8, lines 32-36), or request transfer of said public design data from the design data publicizing processing unit to the user together with an editing program file (FIG. 6 allows selection of information entry in the form of a menu, e.g., menu 604, or transfer of public design data and editing program file by clicking other buttons, e.g., 606 and 608).

**9-2.** Regarding claim 23, Berger et al. disclose a server of a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47); and

Art Unit: 2128

correction data receiving means for receiving correction data as said design data corrected by a user through said computer network and storing said correction data (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9) so as to be usable by design assisting means for reflecting said correction data on product design (to maintain its relative location on the bag when reviewed, column 8, lines 2-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52),

wherein the terminal includes

an information entry selecting means allowing a user to either, enter design information without downloading public design data (Additional instruction dialog boxes ... provide more-specific instructions for producing an actual, physical version of the article, column 8, lines 32-36), or request transfer of said public design data from the design data publicizing processing unit to the user together with an editing program file (FIG. 6 allows selection of information

Art Unit: 2128

entry in the form of a menu, e.g., menu 604, or transfer of public design data and editing program file by clicking other buttons, e.g., 606 and 608).

***Claim Rejections - 35 USC § 103***

**10.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11.** Claims 1, 2, 4, 10, 11, 17, 27-31, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., U.S. Patent 6,414,693 B1 issued July 2, 2002, and filed October 12, 1999, in view of Goldstein, U.S. Patent Application Publication 2001/0032115 A1, published October 18, 2001 and filed December 22, 2000.

**11-1.** Regarding claim 1, Berger et al. disclose a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

correction data receiving means for receiving and storing correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and



Art Unit: 2128

design assisting means for reflecting said correction data (coordinate location, column 8, lines 6-9) received by said correction data receiving means on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving means includes

a data base for registering said correction data (the database, column 4, lines 1-5), and

a received submission processing unit for receiving an electronic submission associated with a specific user to which said correction data [and additional personal information of the specific user] is attached and registering and storing said correction data in said data base (the database is organized so that each unique user of the service is defined as an 'entity' 200, column 4, lines 1-5; the customized bag order can be associated with a given client, column 8, lines 2-16),

said received submission processing unit classifying said attached correction data based on [the additional personal information of] the specific user recited in said received electronic

Art Unit: 2128

submission and registering said correction data in said data base based on the classification results (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Berger et al. fail to expressly disclose “receiving an electronic submission associated with a specific user to which [said correction data and] additional personal information of the specific user is attached” and “classifying said attached correction data based on the additional personal information of the specific user recited in said received electronic submission”.

Goldstein discloses a system giving consumers an opportunity to participate in polls and surveys, thus allowing a consumer to help shape the world around them (abstract) and for customers to be made aware of what issues the consumers, and the marketplace, are giving voice to (paragraph [0016]). Furthermore, Goldstein discloses “My-e-preferences 122 can store personal information about an individual member, such as a member’s age, sex, income, address, telephone number, user interface preferences, personal information disclosure preferences, and the like (paragraph [0064])”, “All surveys are structured in a format that allows the data associated with the use and content of the surveys to be mined for later use by the customers (paragraph [0069])”, “customers can view more detailed demographic data, which can be gleaned by My-e-surveys 150 pulling demographic information from My-e-preferences 122 for each member who answers a question, and also further analyzing and sorting the results according to My-e-profile 121 (paragraph [0077])”, and “Survey response summaries display only statistically significant information, such as, ... gender answer breakdowns, geographic region totals, and chronologically organized result summaries (paragraph [0078])”. In other words, Goldstein discloses survey results display only statistically significant information, such as, ... gender answer breakdowns, geographic region totals by My-e-surveys pulling

Art Unit: 2128

demographic information from My-e-preferences and further analyzing and sorting the results according to My-e-profile. Therefore, even the additional personal information is not attached in the received electronic submission, it is available via My-e-surveys, My-e-preferences, and My-e-profile for analyzing and sorting the results.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the teachings of Goldstein to obtain the invention as specified in claim 1 because analyzed and sorted survey results let customers be made aware of what issues the consumers, and the marketplace, are giving voice to (Goldstein, paragraph [0016]).

**11-2.** Regarding claim 2, Berger et al. further disclose wherein said design data is three-dimensional data (for example, 3D bag, Fig. 7).

**11-3.** Regarding claim 4, Berger et al. further disclose wherein

said editing program file enables editing of three-dimensional data (for example, 3D bag, Fig. 7).

**11-4.** Regarding claim 10, in addition to those limitations have already been recited in claim 1, Berger et al. further disclose in creation of said design data by said design assisting means, said correction data registered in said data base is used (to maintain its relative location on the bag when reviewed, column 8, lines 2-9).

**11-5.** Regarding claim 11, Berger et al. disclose a user's request reflecting design method of timely and accurately reflecting users' requests on a product, comprising the steps of:

publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

receiving correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

reflecting said correction data received on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

wherein said design data publicizing step includes the step of

in response to a request from a terminal connected to said computer network, transferring public design data prepared in advance to be publicized among said design data and an editing program file for editing said public design data to said terminal (By clicking both buttons 606 and 608, the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving step including the steps of

receiving an electronic submission associated with a specific user to which said correction data [and additional personal information of the specific user] is attached, and

classifying said attached correction data based on [the additional personal information of] the specific user recited in said received electronic submission and registering said correction data in a data base based on the classification results (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Berger et al. fail to expressly disclose “receiving an electronic submission associated with a specific user to which [said correction data and] additional personal information of the specific user is attached” and “classifying said attached correction data based on the additional personal information of the specific user recited in said received electronic submission”.

Goldstein discloses a system giving consumers an opportunity to participate in polls and surveys, thus allowing a consumer to help shape the world around them (abstract) and for

customers to be made aware of what issues the consumers, and the marketplace, are giving voice to (paragraph [0016]). Furthermore, Goldstein discloses “My-e-preferences 122 can store personal information about an individual member, such as a member’s age, sex, income, address, telephone number, user interface preferences, personal information disclosure preferences, and the like (paragraph [0064])”, “All surveys are structured in a format that allows the data associated with the use and content of the surveys to be mined for later user by the customers (paragraph [0069])”, “customers can view more detailed demographic data, which can be gleaned by My-e-surveys 150 pulling demographic information from My-e-preferences 122 for each member who answers a question, and also further analyzing and sorting the results according to My-e-profile 121 (paragraph [0077])”, and “Survey response summaries display only statistically significant information, such as, ... gender answer breakdowns, geographic region totals, and chronologically organized result summaries (paragraph [0078])”. In other words, Goldstein discloses survey results display only statistically significant information, such as, ... gender answer breakdowns, geographic region totals by My-e-surveys pulling demographic information from My-e-preferences and further analyzing and sorting the results according to My-e-profile. Therefore, even the additional personal information is not attached in the received electronic submission, it is available via My-e-surveys, My-e-preferences, and My-e-profile for analyzing and sorting the results.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the teachings of Goldstein to obtain the invention as specified in claim 11 because analyzed and sorted survey results let customers be made aware of what issues the consumers, and the marketplace, are giving voice to (Goldstein, paragraph [0016]).

**11-6.** Regarding claim 17, Berger et al. disclose a server of a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47); and

correction data receiving means for receiving correction data as said design data corrected by a user through said computer network and storing said correction data (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9) so as to be usable by design assisting means for reflecting said correction data on product design (to maintain its relative location on the bag when reviewed, column 8, lines 2-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving means includes

a data base for registering said correction data (the database, column 4, lines 1-5), and

Art Unit: 2128

a received submission processing unit for receiving an electronic submission associated with a specific user to which said correction data is attached and registering and storing said correction data in said data base (the database is organized so that each unique user of the service is defined as an 'entity' 200, column 4, lines 1-5; the customized bag order can be associated with a given client, column 8, lines 2-16),

said received submission processing unit classifying said attached correction data based on [said additional personal information of] the specific user recited in the received electronic submission and registering said correction data in said data base based on the classification results (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Berger et al. fail to expressly disclose "classifying said attached correction data based on said additional personal information of the specific user recited in the received electronic submission".

Goldstein discloses a system giving consumers an opportunity to participate in polls and surveys, thus allowing a consumer to help shape the world around them (abstract) and for customers to be made aware of what issues the consumers, and the marketplace, are giving voice to (paragraph [0016]). Furthermore, Goldstein discloses "My-e-preferences 122 can store personal information about an individual member, such as a member's age, sex, income, address, telephone number, user interface preferences, personal information disclosure preferences, and the like (paragraph [0064])", "All surveys are structured in a format that allows the data associated with the use and content of the surveys to be mined for later use by the customers (paragraph [0069])", "customers can view more detailed demographic data, which can be gleaned by My-e-surveys 150 pulling demographic information from My-e-preferences 122 for

Art Unit: 2128

each member who answers a question, and also further analyzing and sorting the results according to My-e-profile 121 (paragraph [0077])”, and “Survey response summaries display only statistically significant information, such as, ... gender answer breakdowns, geographic region totals, and chronologically organized result summaries (paragraph [0078])”. In other words, Goldstein discloses survey results display only statistically significant information, such as, ... gender answer breakdowns, geographic region totals by My-e-surveys pulling demographic information from My-e-preferences and further analyzing and sorting the results according to My-e-profile. Therefore, even the additional personal information is not attached in the received electronic submission, it is available via My-e-surveys, My-e-preferences, and My-e-profile for analyzing and sorting the results.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the teachings of Goldstein to obtain the invention as specified in claim 17 because analyzed and sorted survey results let customers be made aware of what issues the consumers, and the marketplace, are giving voice to (Goldstein, paragraph [0016]).

**11-7.** Regarding claim 27, Goldstein further discloses wherein said additional personal information of the specific user matches categories, wherein said categories are common to a group of users (My-e-preferences 122 can store personal information about an individual member, such as a member’s age, sex, income, address, paragraph [0064]; gender answer breakdowns, geographic region totals, paragraph [0078]).

**11-8.** Regarding claim 28, Goldstein further discloses wherein said correction data is classified according to at least two categories (gender answer breakdowns, geographic region totals, paragraph [0078]).



Art Unit: 2128

**11-9.** Regarding claim 29, Goldstein further discloses wherein said additional personal information of the specific user matches categories, wherein said categories are common to a group of users (My-e-preferences 122 can store personal information about an individual member, such as a member's age, sex, income, address, paragraph [0064]; gender answer breakdowns, geographic region totals, paragraph [0078]).

**11-10.** Regarding claim 30, Goldstein further discloses comprising the step of searching the correction data based upon classified additional personal information (survey response summaries, paragraph [0078]).

**11-11.** Regarding claim 31, Goldstein further discloses wherein said additional personal information of the specific user matches categories, wherein said categories are common to a group of users (My-e-preferences 122 can store personal information about an individual member, such as a member's age, sex, income, address, paragraph [0064]; gender answer breakdowns, geographic region totals, paragraph [0078]).

**11-12.** Regarding claim 35, Goldstein further discloses wherein the additional personal information of the specific user is age, sex and residence of the specific user (My-e-preferences 122 can store personal information about an individual member, such as a member's age, sex, income, address, paragraph [0064]).

**11-13.** Regarding claim 36, Goldstein further discloses wherein the additional personal information of the specific user is age, sex and residence of the specific user (My-e-preferences 122 can store personal information about an individual member, such as a member's age, sex, income, address, paragraph [0064]).

**11-14.** Regarding claim 37, Goldstein further discloses wherein the additional personal information of the specific user is age, sex and residence of the specific user (My-e-preferences

Art Unit: 2128

122 can store personal information about an individual member, such as a member's age, sex, income, address, paragraph [0064]).

**12.** Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., U.S. Patent 6,414,693 B1 issued July 2, 2002, and filed October 12, 1999, in view of Goldstein, U.S. Patent Application Publication 2001/0032115 A1, published October 18, 2001 and filed December 22, 2000.

**12-1.** Regarding claim 32, Berger et al. disclose a user's request reflecting design system in claim 1.

Berger et al. fail to expressly disclose wherein the electronic submission is electronic mail. Nevertheless, using attachment to an electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 32 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

**12-2.** Regarding claim 33, Berger et al. disclose a user's request reflecting design method in claim 11.

Berger et al. fail to expressly disclose wherein the electronic submission is electronic mail. Nevertheless, using attachment to an electronic mail for transferring information is well

Art Unit: 2128

known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 33 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

**12-3.** Regarding claim 34, Berger et al. disclose a server of a user's request reflecting design system in claim 17.

Berger et al. fail to expressly disclose wherein the electronic submission is electronic mail. Nevertheless, using attachment to an electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 34 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

*Applicant's Arguments*

13. Applicant argues the following:

(1) "Claim 27 has been amended to correspond to amended claim 1." (page 12, paragraph 2, Amendment).

(2) "Applicant submits that the "additional personal information" cannot be interpreted as the "name, or identification, of the user" because a specific user is already associated with the correction data, and thus the specific user's name or identification would not need to be included in the additional personal information provided in the electronic submission." (page 13, paragraph 2, Amendment).

(3) "Applicant's independent claim 11 is a method claim and is distinguished over Berger for reasons analogous to those recited for claim 1." (page 13, paragraph 4, Amendment).

(4) "Applicant's independent claim 17 is an apparatus claim and is distinguished over Berger for reasons analogous to those recited with respect to claim 1." (page 13, paragraph 5, Amendment).

(5) "Berger simply allows the user to select a method of downloading public design data, either by picking a style from a menu list, or by entering a previously determined identifying number. There is no disclosure in Berger of an alternative to downloading the public design data. Therefore, claim 9 patentably distinguishes over the prior art." (page 14, paragraph 3, Amendment).

(6) "Applicant's claim 23 is a related independent server apparatus claim and is distinguished over Berger for reasons analogous to those recited with respect to claim 9." (page 14, paragraph 4, Amendment).

***Response to Arguments***

**14.** Applicant's arguments have been fully considered.

**14-1.** Applicant's argument (1) is persuasive. The rejections of claim 27 under 35 U.S.C. 112, second paragraph, in Office Action dated January 12, 2007, have been withdrawn.

**14-2.** Applicant's arguments (2)-(4) are moot in view of the new ground(s) of rejection as detailed in paragraphs 11 to 12-3 above. The rejections of claims 1, 2, 4, 10-11, 17, and 24-29 under 35 U.S.C. 103(a) in Office Action dated January 12, 2007, have been withdrawn.

**14-3.** Applicant's argument (5) is not persuasive. Berger et al. disclose in column 8, lines 32-36, "Additional instruction dialog boxes (not shown) can appear, according to an alternate embodiment, following a submission of a custom design by the client to provide more-specific instructions for producing an actual, physical version of the article" and in column 8, lines 42-45, "A variety of dialog boxes can be provided to facilitate on-line ordering of submitted bags according to current, widely employed principles of e-commerce". In other words, other than downloading the public design data, a client may use the additional instruction dialog boxes to provide data, e.g., correction data.

**14-4.** Applicant's argument (6) is not persuasive because the argument regarding claim 1 is not persuasive as detailed in paragraph 14-3 above.

***Conclusion***

**15.** The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Reference to Robb et al., U.S. Patent 6,952,716 B1 issued October 4, 2005, and filed July 12, 2000, is cited as disclosing collecting real-time data related to network user choices.

Art Unit: 2128

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kamini S. Shah can be reached on (571) 272-2279. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2128

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day  
June 23, 2007

H.D.

  
KAMINI SHAH  
SUPERVISORY PATENT EXAMINER